

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111, and in light of the remarks which follow, are respectfully requested.

Claim 1 has been amended to incorporate the subject matter of claim 2, except for the exclusion of formula (4) in original claim 2, and claim 2 has accordingly been canceled without prejudice or disclaimer. Claim 1 has also been amended to recite that n is an integer of 2 to 4. This amendment is supported by the specification, at least at page 6. In addition, claim 3 has been amended to change the dependency thereof. Further, claims 1, 4 and 9 have been amended to delete the word "general." Moreover, claim 5 and 10 have been amended to replace the phrase "a curing layer of 2 μm thickness that the composition" with "a layer of the composition having a thickness of 2 μm that."

Upon entry of the Amendment, claims 1 and 3-12 will be all the claims pending in the application.

I. Priority Claim

Applicants note that the certified copies of Applicants' priority documents, i.e., JP 2002-212862 and JP 2003-53696, are of record, as shown in the PTO PAIR system. The Examiner is respectfully requested to acknowledge Applicants' priority claim and confirm receipt of the certified copies of priority documents in the next PTO communication.

II. Response to Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 1-12 were rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth at page 2 of the Office Action.

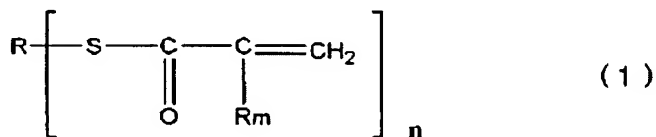
As noted above, claims 1, 4 and 9 have been amended to delete the word "general." In addition, claims 5 and 10 have been amended to further improve their clarity. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection under 35 U.S.C. § 112, second paragraph.

III. Response to Rejection under 35 U.S.C. § 102

Claims 1, 2 and 10-12 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,656,990 to Shustack et al. for the reasons discussed at page 3 of the Office Action.

Applicants respectfully submit that the present claims are novel over Shustack et al. for at least the following reasons.

Present claim 1 relates to a composition comprising (a) a thio(meth)acrylate compound represented by the formula (1) and (b) ultrafine inorganic particles:



wherein a linking (or connecting) group R represents one of the formulae (2), (3), (5) and (6).

Shustack et al. is relied upon as disclosing a composition comprising bis(4-methacryloylthiophenyl)sulfide, which does not satisfy the requirements of the formula (1) recited in the present claims as amended. For at least this reason, Shustack et al. does not anticipate the present claims. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the § 102 rejection.

IV. Response to Rejections under 35 U.S.C. § 103(a)

Claim 2 was rejected under 35 U.S.C. § 103(a) as obvious over Shustack et al. in view of each of JP 08-295665 (JP '665), JP 09-132563 (JP '563) or JP 09-309923 (JP '923) for the reasons presented at pages 4-5 of the Office Action. Further, claim 3 was rejected under 35 U.S.C. § 103(a) as obvious over Shustack et al. in view of each of JP '665, JP 563 or JP '923, and further in view of EP 0 378 895 (EP '895) for the reasons advanced at page 5 of the Office Action. Moreover, claim 8 was rejected under 35 U.S.C. § 103(a) as obvious over Shustack et al., and further in view of EP '895 for the reasons set forth at page 6 of the Office Action.

Applicants respectfully submit that the present claims are patentable over the cited references for at least the following reasons.

As described in the present specification, the present invention can provide unexpectedly superior results. In particular, as the results in Table 1 show, Examples 1-15, which contain an ultrafine inorganic particle, generally have a higher refractive index, compared to those without ultrafine inorganic particles (Δn in Table 1 shows a difference between a refractive index in which the ultrafine inorganic particles are present and a refractive index in which the particles are absent). Additionally, as shown in Table 2, Examples 16-22 which employ a compound represented by formula (1) recited in claim 1, are superior in overall results of adherence, pencil hardness, scratch resistivity and light resistance, compared to Comparative Examples 9 and 10, which employ diethylene glycol diacrylate or trimethylol propane triacrylate instead of a thio(meth)acrylate compound. None of Shustack et al., JP '665, JP '563 and JP '923 disclose or suggest the above superior results of the present invention. Further, EP '895 does not rectify the deficiencies of Shustack et al., JP '665, JP '563 and JP '923.

In view of the above, Applicants respectfully submit that the present claims are not obvious over the cited references and thus the rejections should be withdrawn.

V. Allowable Subject Matter

It is indicated that claims 4-7 and 9 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph, and to include all the limitations of the base claim and any intervening claims.

As noted above, claims 4, 5 and 9 have been amended to overcome the § 112, second paragraph, rejection. Claims 6 and 7 depend from claim 5. Moreover, Applicants respectfully submit that the rejections of claim 1, from which claims 4-7 and 9 depend, directly or indirectly, have been overcome as set forth above. Accordingly, the Examiner is respectfully requested to reconsider and allow claims 4-7 and 9.

VI. Conclusion

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (202) 452-7932 at his earliest convenience.

Respectfully submitted,

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By: _____



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